

REMARKS

This paper is submitted in reply to the Office Action mailed April 28, 2009.

In the Office Action, claims 1-6, 8, 10, 11, and 48-51 are listed as pending, no claims are listed as withdrawn from consideration and claims 1-6, 8, 10, 11, and 48-51 are listed as rejected. Applicants respectfully request reconsideration and entry of the foregoing amendments. Applicants have cancelled claims 48 and 49 without waiver or prejudice and reserve the right to pursue the cancelled subject matter in a continuation or divisional application.

Applicants gratefully acknowledge that the Examiner has withdrawn the obviousness-type double patenting rejection over U.S. 6,660,744 and the prior art rejection over WO98/41525.

Applicants also gratefully acknowledge that the Examiner has rejoined claims 48-51.

Applicants have amended claim 1 to delete “substituted or unsubstituted” at the end of the definition of “D”.

Applicants have amended claim 11 to change “C3-C8” to “C₃-C₈” cycloalkyl group, a “C5-C7” to “C₅-C₇” cycloalkenyl group and “C1-C6-alkyl” to “C₁-C₆” in optionally substituted phenyl(“C1-C6”)alkyl group.

The Examiner has rejected claims 1-6, 8 and 10-11 under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a compound represented by the formula depicted in claim 1 wherein ring A is a five or six membered heteroaromatic ring and L is an independent group, allegedly does not reasonably provide enablement for a compound of the formula wherein:

“L is -R_bN(R)S(O)₂-, -R_bN(R)P(O)-, or -R_bN(R)P(O)O-, wherein R_b is an alkylene group which when taken together with the sulphonamide, phosphinamide or phosphonamide group to which it is bound forms a five or six membered ring fused to ring A.

Without conceding to the correctness of the Examiner’s rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, Applicants have amended claim 1 to delete the above phrase from the definition of Ring A.

Based upon the foregoing, the rejections of claims 1-6, 8 and 10-11 under 35 U.S.C. §112, first paragraph, as allegedly not being enabled is obviated and should be withdrawn.

The Examiner has rejected claims 6, 11 and 48-50 under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons.

1. The Examiner states “[c]laim 6 recites the limitation ‘ring A is substituted with one or more substituents selected from the group consisting of CN, CO₂CH₃,...carboxyl...’ in lines 1-7. There is insufficient antecedent basis for this limitation in claim 1 on which claim 6 is dependent (via claim 5).”

Applicants respectfully point out that claim 1 contains “cyano” as a substituent for Ring A. One of ordinary skill in the art would recognize “CN” to be the same as “cyano”. Applicants have amended claims 6 and 11 to replace “CN” with “cyano” so that the wording in the claims is consistent.

Applicants have deleted CO₂CH₃ and “carboxyl” from claim 6.

The Examiner also states that “..claim 6 recites that ‘ring A is substituted with....-S-(substituted or unsubstituted aryl),...’ which is not identically listed in claim 1.” The Examiner points out that the terminology used in claim 1 to describe this group is “substituted or unsubstituted arylthio.” Applicants have amended claim 6 to delete “-S-(substituted or unsubstituted aryl)” and replace it with “substituted or unsubstituted arylthio.”

2. The Examiner states “[i]n claim 11, it is recited that ‘L is -NHSO₂R-,...or -NHC(O)R-; wherein R is an acyl group,...’ and the specification at page 23 provides that...the definition of ‘an acyl group’ appears to represent a monovalent group...” Applicants have amended claim 11 to delete “an acyl group” from the definition of “R”.

3. The Examiner states “[c]laim 48 recites the limitation ‘L is -NHSO₂CH₂-,-NHC(O)CH₂-,-NHSO₂CH=CH-’ in lines 1-2. There is insufficient antecedent basis for this limitation I claim 1.” Applicants have cancelled claim 48.

4. The Examiner states “[c]laim 49 does not further limit claim 1.” Applicants have cancelled claim 49 with out waiver or prejudice and for the sole purpose of expediting prosecution of the instant application.

5. The Examiner states “[c]laim 50 recites the limitation ‘L is...-CH₂N(R)-;-CH(NR)-;...-NHC(O)R₁₃₀-;...-NHSO₂R₁₃₀-;...’...[t]here is insufficient antecedent basis for this limitation. Applicants have amended claim 50 to delete -CH₂N(R)-;-CH(NR)-;-NHC(O)R₁₃₀-;

and -NHSO₂R₁₃₀. and the phrase “and R₁₃₀ is an aliphatic group” for the sole purpose of expediting prosecution of the instant application.

Based upon the foregoing, the rejection of claims 6, 11 and 48-50 under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is obviated and should be withdrawn.

The Examiner has advised Applicants that should claim 1 be found allowable, claim 49 will be objected to under 3u7 C.F.R. 1.75 as being a substantial duplicate thereof. Applicants cancelled claim 49 in response to the rejection of claim 49 under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has maintained the rejection of claims 1-6, 8, 10-11, and 48-52 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-63 of U.S. Patent No. 6,713,474. Upon receiving a Notice of Allowability wherein the rejection of claims 1-6, 8, 10, 11, 48 and 50-51 the on the ground of nonstatutory obviousness-type double patenting over claims 1-63 of U.S. Patent No. 6,660,744 is the only remaining issue Applicants will address the issue of nonstatutory obviousness-type double patenting over claims 1-63 of U.S. Patent No. 6,713,474.

In view of the foregoing remarks, Applicants believe that claims 1-6, 8, 10, 11, and 48 and 50-51 are in condition for allowance. Prompt and favorable action is earnestly solicited.

No additional claims fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

Date: July 22, 2009

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